

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : **6,308,317**
Application No. : **08/957,512**
Re-examination No. : **90/008,178**
Confirmation No. : **2195**
Applicant : **Wilkinson, Timothy J., et al.**
Issue Date : **Oct. 23, 2001**
Docket No. : **40.0010**
Customer No. : **41754**

Decisions and Certificate of Corrections Branch
Commissioner for Patents
P.O.Box 1450
Alexandria, VA, 22313-1450

**RESPONSE TO DENIAL OF REQUEST FOR CERTIFICATE OF
CORRECTION**

Dear Sir:

In response to the letter entitled “Re: Request for Certificate of Correction” dated April 5, 2012 and containing a denial of the request for certificate of correction (“April 5 Letter”), Applicants respectfully request reconsideration in light of the arguments set forth in the petitions filed herein on 30 July 2010 and filed in the companion reexamination 90/008,178 on 2 February 2011 (collectively, the “Petitions”), the arguments made therein are incorporated herein by reference. Applicants further respectfully request favorable decisions to be made on these petitions in a timely manner.

History

On February 21, 2008, Applicants filed in 90/008,178 a document entitled **REPLY AND AMENDMENT UNDER 37 CFR 1.111 and 37 CFR 1.530**. In that reply Applicants made an amendment to all occurrences of the same limitation in the claims. This amendment was made using what is commonly referred to as a “global search and replace”, thereby automatically directing the word processor to change all occurrences in the document from one text string to another, namely, “a format suitable for interpretation” was changed into “an instruction set supported by an interpreter on the integrated circuit card[a format suitable for interpretation].” This change was made to all claims in which the string “a format suitable for interpretation” occurred. In this amended text in Claim 1, for example, “the integrated circuit card” obtains its antecedent basis from the preamble.

Subsequently Applicants discovered that the global-search-and-replace approach to making the amendments in the February 21, 2008 document introduced an unintended amendment to several of the claims. Take, for example, Claim 58. The preamble of Claim 58 is to “A microcontroller comprising.” Thus, the amended text – “an instruction set supported by an interpreter on the integrated circuit card – cannot obtain its antecedent for “the integrated circuit card” from the preamble.

To correct the unintended amendment, Applicants have filed petitions in this case and in 90/008,178 (the Petitions) accompanied by a request for certificate of correction. The request quite simply asks for changing the text “the integrated circuit card” to “a microcontroller” so that there is congruence between the body of the text after the preamble whereby antecedent basis may be established in the same manner in

Claim 58 (and other claims to which the request pertains) as is established in Claim 1.

The table below illustrates the sequence of Petitions, related documents and USPTO decisions:

6,308,317 (08/957,512)	90/008,178 (the Reexam)
	21-FEB-2008 Amendment with following amendment: <u>an instruction set</u> <u>supported by an</u> <u>interpreter on the</u> <u>integrated circuit</u> <u>card[a format</u> <u>suitable for</u> <u>interpretation]</u>
30-JUL-2010 Petition to correct mistake and Request for Certificate of Correction	
	24-aug-2010 SPE Response by Eric Keasel denying the request as not being a typographical, clerical error of minor nature
6-Oct-2010 Petition under 1.181	24-aug-2010 SPE Response by Eric Keasel denying the request as not being a typographical, clerical error of minor nature (Same doc in both file wrappers)

	3-jan-2011 SPE Response by Eric Keasel again denying the request (same wording as the 24-Aug document but clearly not the same document)		
			7-jan-2011 Request Denied from Corrections Branch
		2-feb-2011 Petition under 1.181	
		18-Jul-2011 Status Request	
	5-apr-2012 Request Denied from Corrections Branch referencing Erik Keasel (No reference is made to the Petition)		

Discussion

The April 5 Letter makes reference to “your request for the issuance of a certificate of correction.” However, it does not make any reference whatsoever to the petitions filed on 6 October 2010 in this patent or on 2 February 2011 in the corresponding reexam (90/008,178). Applicants therefore surmise that no consideration has yet been given to the petitions or the arguments set forth therein and that the April 5 Letter is in reaction to the SPE responses of 24 August 2010 and 3 January 2011 without any consideration of the Petitions.

The April 5 Letter states that “the requested changes are not of a clerical nature, a typographical error, or a mistake of minor character. (Per say Spec-AU 3992) Eric S. Keasel.” Applicants respectfully disagree.

The legal precedence discussed in the petitions establishes the conditions under which a certificate of correction should be granted. Applicants have argued in the petitions that the requested certificate of correction meets those requirements. Applicants incorporate the arguments made in the petitions herein by reference in their respective entireties.

Applicants further disagree with Examiner Keasel's view that the requested changes do not correct defects of a clerical nature, a typographical error, or a mistake of minor character.

Certificate of Correction may be used under certain conditions to correct an Applicant mistake:

mistake must be of a clerical or typographical nature, or of minor character, the correction of which does not involve such changes in the patent as would constitute new matter or would require reexamination (35 U.S.C. § 255).

The mistake in question was inadvertently made during the crafting of the 21 February 2008 amendment. It occurred because of the undersigned's use of global-search-and-replace to insert the amendment text into the claims whereas more careful attention to the correspondence between each claim's preamble and the added text. Thus, the mistake *was* a *clerical* mistake.

A *typographical error* is “an error (as of spelling) in typed or typeset material.” *Typo*, Merriam-Webster Online Dictionary, <http://www.merriam-webster.com/dictionary/typo> (accessed on April 30, 2012). In the past a mistakenly hit key on a typewriter keyboard would produce words with mangled letter-order or inadvertent introduction of an unintended letter in a word. Applicants posit that in the era of word

processing the process for producing documents has changed vastly from traditional typing and typesetting and that in the present, an inadvertent click on a button, e.g., a click on a “change all” button, can cause a widespread mistake throughout a document. Thus, in the present case, the mere execution of a “change all” caused the mistake. Applicants posit that this is analogous to *typographical* error as encountered in the days of manual typing and typesetting because a similarly clumsy move that would produce an incorrect letter order can now produce larger discrepancies in a document.

Applicants have argued at length in the Petitions that the mistake was of a minor character and respectfully repeat those arguments here by reference.

Request

Applicants respectfully request reconsideration of the denial of the request for certificate of correction based on the discussion made herein and in the Petitions, and that the requested certificate of correction be granted.

Applicants further respectfully request timely decisions on the Petitions.

Applicants further make a status inquiry and respectfully request that the Commissioner informs the Applicants as to when the Petitions will be considered and when decisions on the Petitions will be made.

Fee

The Commissioner is hereby authorized to charge the \$100.00 fee required with for responding to the April 5 Letter (and any other required fees in conjunction with the filing of this Response or the Petitions) from deposit account 502114.

Respectfully submitted,

Date: May 2, 2012

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